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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,163	09/24/2001	Adelbert Bacher	9286.3	7050

20792 7590 04/23/2003

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EXAMINER

SAUCIER, SANDRA E

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 04/23/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/868,163

Applicant(s)  
Bacher et al.

Examiner  
Sandra Saucier

Art Unit  
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 17, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above, claim(s) 19-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Sep 24, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7 6) ☐ Other:

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#### **DETAILED ACTION**

Claims 1-28 are pending. Claims 1-18 are considered on the merits. Claims 19-28 are withdrawn from consideration as being drawn to a non-elected invention.

#### ***Election/Restriction***

Applicant's election of Group I in Paper No.10 is acknowledged. The traversal is based on the allegation that the general inventive concept is "inhibitors of the pathway of terpenoids via 1-deoxy-D-xylulose-5-phosphate in plants".

This is not persuasive because "general invention concept" is not the standard in governing the restriction of inventions. The standard is "special technical feature", further, an international or national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the of following combinations of categories;

(1) a product and a process specially adapted for the manufacture of said product; or

(2) a product and a process of use of said product; or

(3) a product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) a process and a apparatus specifically designed for carrying out said process; or

(5) a product, a process specially adapted for the manufacture of the said product and an apparatus specifically designed for carrying out said process.  
37 CFR 1.475.

PCT Rule 13 does not provide for multiple compositions or multiple methods of use within a single application. Thus, the first appearing composition is combined with a corresponding first method of use and the additional composition and method claims each constitute a separate group.

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Further, the inventions listed as Groups I–VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features.

The expression “special technical feature” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art (PCT Rule 13.2). Thus, a feature found in the prior art cannot be considered to be a special technical feature.

Evidence was presented in the restriction requirement mailed 2/11/03 that the first mentioned product is known in the art.

Thus the argument is unpersuasive.

***Claim Rejections – 35 USC § 112***

**INDEFINITE**

Claims 1–18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 in the preamble states that the pathway to be tested for inhibitors is in plants; however, step (a) does not require that the cells or plastid bearing organism be a plant. Thus, the metes and bounds of the claim are uncertain.

Claim 3 does not require that the suspension in step (a) be a plastid, but only if it is a plastid, that it be a chromoplast or a chloroplast.

***Claim Rejections – 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent, (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Haughan *et al.* [U].

The claims are directed to a method for use in screening for the presence of inhibitors in the terpenoid pathway via 1-deoxy-D-xylulose-5-phosphate in plants comprising:

- (a) preparing a suspension of cells or plastids in a culture medium,
- (b) adding a labeled terpenoid precursor,
- (c) incubating,
- (d) separating the product downstream from 1-deoxy-D-xylulose-5-phosphate,
- (e) repeating a-d with the addition of a test compound,
- (f) comparing the control with the value obtained with the test compound was added to the incubation.

The references are relied upon as explained below.

Haughan *et al.* disclose a method comprising:

- (a) preparing a cell suspension of celery cells in a culture medium,
- (b) adding a labeled terpenoid precursor ( $C^{14}$  acetate),
- (c) incubating,
- (d) isolating  $4\alpha$ -methylsterols by extraction,
- (e) repeating with addition of pacloburazol,
- (f) comparing the control value with the value obtained when pacloburazol was added to the incubation. (Table 1).

Claims 1-5, 7 and 18 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Fellermeier *et al.* [V].

The claims have been discussed above.

Fellermeier *et al.* disclose a method comprising:

- (a) preparing a suspension of chromoplasts in a culture medium containing ATP and labeled IPP,
- (b) adding the labeled terpenoid precursor,  $[1,2-^{14}C]$  1-deoxy-D-xylulose-5-phosphate or  $[1^3H]$  2-C-methyl-D-erythritol-4-phosphate or  $[1^{14}C]$  isopentenyl phosphate

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- (c) incubating,
- (d) separating the product downstream (carotenes) from 1-deoxy-D-xylulose-5-phosphate by extraction
- (e) repeating a-d with the addition of a test compound, such as fosmidomycin
- (f) comparing the control with the value obtained with the test compound was added to the incubation.

With regard to claim 5, a source for CTP might be considered to be ATP, since the directness of the source is not specified. Energy pathways allow for the conversion of one high energy compound into another.

Claims 6, 8-17 appear to be free of the art.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal work schedule for Examiner Saucier is 8:30 AM to 5:00 PM Monday and Tuesday and 8:30 AM to noon on Wednesday.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198. The number of the Fax Center for the faxing of official papers is (703) 872-9306 or for after finals (703) 872-9307.



Sandra Saucier  
Primary Examiner  
Art Unit 1651  
April 17, 2003